

03/06/02  
1c931 U.S. PTO

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ET 684369045 US

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PTO/SB/05 (03-01)  
Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No. 609920-600-025  
First Inventor Yang et al.  
Title Method for Synthesizing 5 $\beta$ , 6 $\beta$ -Epoxides of Steroids by a Highly  $\beta$ -Selective Epoxidation of  $\Delta^4$ -Unsaturated Steroids Catalyzed by Ketones  
Express Mail Label No. ET684369045US

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents  
Box Patent Application  
Washington, DC 20231

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☒ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 71]  
(preferred arrangement set forth below)
- Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 58]
5. Oath or Declaration [Total Pages ]
- a. ☐ Newly executed (original or copy)
- b. ☐ Copy from a prior application (37 CFR 1.63 (d))  
(for continuation/divisional with Box 18 completed)
- i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
- ii. ☐ paper
- c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement of Power of Attorney (when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 [Copies of IDS Citations]
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☐ Other: \_\_\_\_\_

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☐ Divisional ☒ Continuation-in-part (CIP) of prior application No.: 09 / 788,201  
Prior application information: Examiner B. Badio, PhD. Group Art Unit: 1616

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label (Insert Customer No. or Attach bar code label here) or ☒ Correspondence address below

Name Sandra B. Weiss  
Address Jones, Day, Reavis & Pogue  
77 West Wacker  
City Chicago State Illinois Zip Code 60601  
Country USA Telephone 312/782-3939 Fax 312/782-8585

Name (Print/Type) Sandra B. Weiss Registration No. (Attorney/Agent) 30,814  
Signature [Signature] Date 3/6/02

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

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# FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 883.00)

## Complete if Known

Application Number

Filing Date

First Named Inventor

Yang et al.

Examiner Name

Barbara P. Badio, PhD.

Group Art Unit

1616

Attorney Docket No.

609920-600-025

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit Account Number  
Deposit Account Name

10-1202

Jones, Day, Reavis  
& Pogue

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
101	740	201	370	Utility filing fee	370.
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$ 370.)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
63	-20** = 43	9.00	387.
6	-3** = 3	42.00	126.
Multiple Dependent			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 513.00)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

## SUBMITTED BY

Name (Print/Type)

Sandra B. Weiss

Registration No.  
(Attorney/Agent)

30,814

## Complete (if applicable)

Telephone

312/782-3939

Signature

Sandra B. Weiss

Date

3/6/02

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

In re application of: Yang et al.

Application No.: 09 / 788,201 Group No.: 1616

Filed: February 16, 2001 Examiner: Barbara P. Badio, Ph.D.

For: Method for Synthesizing 5 $\beta$ , 6 $\beta$ -Epoxides of Steroids by a Highly  $\beta$ -Selective  
Assistant Commissioner for Patents Epoxidation of  $\Delta^5$ -Unsaturated Steroids Catalyzed  
Washington, D.C. 20231 by Ketones

NOTIFICATION OF FILING OF CONTINUING,  
DIVISIONAL OR CONTINUED PROSECUTION APPLICATION

Notification is hereby being made of the filing of a:

- ☐ continuation
- ☒ continuation-in-part
- ☐ divisional
- ☐ continued prosecution

application for this case

- ☒ concurrently herewith.

☐ on \_\_\_\_\_

Date

11017 U.S. PTO  
10/091627  
03/06/02

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10**  
(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231  
37 C.F.R. § 1.8(a)
- ☐ with sufficient postage as first class mail.

☒ as "Express Mail Post Office to Addressee"  
Mailing Label No. ET68436907US (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Paulette K. Haseltine  
Signature

Date: 3/6/02

Paulette K. Haseltine

(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by Express Mail must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

(Notification of Filing of Continuing, Divisional or Continued Prosecution Application [4-8] (page 1 of 2))

Reg. No. 30,814

Tel. No.: (312) 782-3939

Customer No.:

Sandra B. Weiss  
SIGNATURE F PRACTITIONER

Sandra B. Weiss

*(type or print name of practitioner)*

Jones, Day, Reavis & Pogue  
77 West Wacker

P.O. Address

Chicago, Illinois 60601-1692

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Yang et al.

Application No.: 09 /788,201 Group No.: 1616

Filed: February 16, 2001 Examiner: Barbara P. Badio, Ph.D.

For: Method for Synthesizing  $5\beta$ ,  $6\beta$ -Epoxides of Steroids by a Highly  $\beta$ -Selective Epoxidation of  $\Delta^5$ -Unsaturated Steroids Catalyzed by Ketones  
Assistant Commissioner for Patents Washington, D.C. 20231

AMENDMENT, PETITION AND FEE FOR EXTENSION OF TIME  
TO MAINTAIN PARENT CASE THAT IS TO BE ABANDONED  
WHEN FILING NEW APPLICATION CLAIMING ITS BENEFIT

NOTE: Where an extension of time is sought solely for the purpose of filing a continuation application under 35 U.S.C. § 120, and where the prior application is to be abandoned in favor of the continuing application, the filing of a response as required by 37 C.F.R. §§ 1.111 or 1.113 is considered to be an unnecessary expenditure of resources by the applicant and, in these situations, the PTO will accept the filing of a continuing application as a response under 37 C.F.R. § 1.136. Notice of May 13, 1983 (1031 O.G. 11).

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of Nov. 5, 1985 (1060 O.G. 27).

1. The amendment in this case is a *bona fide* attempt by applicant to respond and to advance this application to final action. It comprises a separately filed:

(check (a), (b), or (c), as applicable)

(a) ☐ Continuation application

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

☐ with sufficient postage as first class mail.

☒ as "Express Mail Post Office to Addressee"

Mailing Label No. ET 684369037 (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Paulette K. Haseltine  
Signature

Date: 3/10/02

Paulette K. Haseltine  
(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Amendment, Petition and Fee for Extension of Time t Maintain Parent Case That is to be Abandoned When Filing Applicant Claiming Its Benefit [4-5]—page 1 f 3)

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03/06/02

(b) ☒ Continuation-in-part application

(c) ☐ Divisional application (where parent case is to be abandoned)

A copy of this amendment and petition is being filed with the papers constituting the filing of the separately filed application.

2. This is a petition under 37 C.F.R. § 1.136(a) for an extension of time to respond to

(check and complete (d) or (e), as applicable)

(d) ☒ the Office Action mailed September 7, 2001

(e) ☐ other \_\_\_\_\_

3. Please abandon this application conditioned upon the granting of the petition and the granting of a filing date to the continuing application, so as to make the continuing application copending with this application. (Notice of May 13, 1983, 1031 O.G. 11-12).

4. Applicant is

☒ a small entity.

The statement:

☐ is enclosed.

☐ is already filed in the parent application. This status is still proper and its benefit under 37 C.F.R. § 1.28(a) is hereby claimed.

☐ other than a small entity.

5. Extension requested

NOTE: 37 C.F.R. § 1.704 (b) " . . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☒ Applicant petitions for an extension of time under 37 C.F.R. § 1.136(a) (fees: 37 C.F.R. § 1.17(a)(1)-(4)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$ 200.00
<input checked="" type="checkbox"/> three months	\$ 920.00	\$ 460.00
<input type="checkbox"/> four months	\$ 1,440.00	\$ 720.00

Fee: \$ 460.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

6. Fee Payment

- ☒ Attached is a check in the sum of \$ 460.00.
- ☒ Charge Account No. 10-1202XXXXXX any fee deficiency or credit.
- A duplicate of this transmittal is attached.

7. Fee Deficiency

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986 (1065 O.G. 31-33).

- ☒ The Office is hereby authorized to charge, in the manner shown above, the following additional fees that may be required by this paper and during the entire pendency of this application.

Reg. No.: 30,814

Tel. No. (312) 782-3939

Customer No.:

Sandra B. Weiss  
SIGNATURE OF PRACTITIONER

Sandra B. Weiss

(type or print name of practitioner)  
Jones, Day, Reavis & Pogue  
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Chicago, Illinois 60601-1692